

CUSTOMER NO. 24498
Serial No.: 09/445,135

RCA 88,682

AF/2614
JW



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Board of Patent Appeals and Interferences

Patent Application

Inventor(s) : RANDALL et al.
Serial No. : 09/445,135
Filed : 03-13-2000
Title : SYSTEM AND METHOD FOR SORTING PROGRAM GUIDE
INFORMATION
Examiner : SCOTT E. BELIVEAU
Art Unit : 2614

APPEAL BRIEF

May It Please The Honorable Board:

This is Appellants' Brief on Appeal from the final rejection of claims 1 – 13.
Please charge the \$330.00 fee for filing this Brief to Deposit Account No. 07-0832.
Appellants waive an Oral Hearing for this appeal.

Please charge any additional fee or credit overpayment to the above-indicated
Deposit Account. Enclosed is a single copy of the Brief.

I. REAL PARTY IN INTEREST

The real party in interest of Application Serial No. 09/445,135 is the Assignee of
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Signature Lori Klewin Date: 4-4-05

II. RELATED APPEALS AND INTERFERENCES

There are currently, and have been, no related Appeals or Interferences regarding Application Serial No. 09/445,135 known to the undersigned representative.

III. STATUS OF THE CLAIMS

Claims 1-13 are rejected and the rejection of claims 1-13 are appealed.

IV. STATUS OF AMENDMENTS

All amendments were entered and are reflected in the claims included in Appendix I.

V. SUMMARY OF CLAIMED SUBJECT MATTER

This summary sets forth exemplary reference characters and pages and line numbers in the specification where an embodiment of each separately argued claim is illustrated or described. The identification of reference characters and pages and line numbers does not constitute a representation that any claim element is limited to the embodiment illustrated at the reference character or described in the referenced portion of the specification.

Independent claim 1 claims an apparatus in which program guide information (page 23, line 18) containing a respective program description for programs (page 24, lines 25-26, and Fig. 9) is processed to form a program guide (page 23, line 24, and Fig. 9), comprising: control means (page 23, lines 3-4) for displaying concurrently a list of program descriptive fields and an entry for entering a text string (page 27, lines 12-15 and Fig. 9); user control means (page 8, line 18, Fig 3 ref.# 314) for allowing a user to select a program descriptive field (page 27, lines 16-18) from the list of program descriptive fields (page 27, line 15, Fig. 9) and to enter a text string having one or more user-selectable characters in the entry (page 27, line 22 and Fig. 9); and the control means (page 23, lines 3-4) for performing an alphabetical sort (page 28, line 1) of the programs in response to the user selection of the

program descriptive field (page 27, line 19) and for locating a first program with the respective program description (page 27, lines 22-24) in the selected program description field (page 27, line 24, Fig. 9) in response to the entered text string based on the entered text string (page 27, line 22).

Independent claim 6 claims a method for processing program guide information (page 25, lines 18-22) containing a respective program description for programs (page 24, lines 23-26), comprising the steps of: displaying concurrently a list of program descriptive fields and an entry for entering a text string (page 27, lines 12-15 and Fig. 9); selecting a program descriptive field from the list of program descriptive fields (page 27, lines 16-18), performing an alphabetical sort of the program guide information based on the selected program descriptive field (page 27, lines 19-27) displaying concurrently the list of program descriptive fields (Fig. 9), the entry for entering a text string (Fig. 9), and the alphabetically sorted program guide information (Fig. 9); entering a text string having one or more user-selectable characters in the entry (page 27, line 22); and locating a first program with the respective program description in the selected program description field matching the entered text string (page 27, lines 23-27).

Independent claim 12 claims an apparatus in which channel guide information containing a respective program description for programs is processed to form a channel guide (page 23, line 21, Fig. 4), comprising: control means (page 23, lines 3-4) for displaying concurrently a list of program descriptive fields and an entry for entering a text string (Fig. 9); user control means (page 8, line 18, Fig 3 ref.# 314) for allowing a user to select a program descriptive field (page 27, lines 16-18) from the list of program descriptive fields (page 27, line 15, Fig. 9) and to enter a text string having one or more user-selectable characters in the entry (page 27, line 22); and the control means (page 23, lines 3-4) for

performing an alphabetical sort of the programs based on the selected program descriptive field, modifying the channel guide based on the selected program descriptive field (page 27, line 22), and for locating a first program with the respective program description in the selected program description field (page 27, line 25) matching the entered text string based on the entered text string.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The Examiner has rejected claims 1 – 13 under 35 USC 103(a) as being unpatentable over Youman et al. (WO/96/17473) in view of Torres (U.S. 5,410,692).

VII. ARGUMENT

Rejection of Claims 1 – 13 under 35 USC 103(a) over Youman et al. (WO/96/17473) in view of Torres (U.S. 5,410,692).

CLAIMS 1-5

The invention as recited in independent claim 1 is not rendered obvious by the combination of Youman and Torres proposed by the Examiner, as the proposed combination would not result in all of the limitations of claim 1.

The standard for a *prima facie* case of obviousness is the following:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. **Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.** . . . *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (*emphasis added*)

MPEP §2142 (8th edition, rev. 2, 2004)

In the present case, the Examiner has failed to establish a *prima facie* case of obviousness, as the cited references, even when combined, fail to teach or suggest all the limitations of claim 1.

The invention of claim 1 is an apparatus in which program guide information is processed such that program descriptive fields and an entry for a text string are displayed concurrently. This feature has the desirable and intended benefit to permit the user to change the sorting criteria, such as a character in the text string or the program descriptive field and instantly see the results of the sort. The apparatus further performs an alphabetical sort of the programs in response to the user selection of the program descriptive field and an entered text string. This alphabetical sort rearranges the order of the programs in the alphabetical list of programs using the selected program descriptive field as the key to the sort (page 27, lines 15-27).

The examiner concurs that Youman et al. does not disclose "displaying concurrently a list of program descriptive fields" and "an entry for entering a text string" as recited by the current claim 1. However, the examiner continues to assert that these features would be an obvious design choice to one skilled in the art. The examiner points to only the vague boilerplate language in Youman that states "those skilled in the art will recognize that there are many possible variations to the embodiment" to support his assertion. It is submitted that this language cannot possibly be found to anticipate every possible variation to a user interface from that point forward, thereby precluding any future patent in the field. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the reference, of which there is neither in Youman, and therefore it is submitted that the rejection over Youman cannot be sustained.

The examiner further reasons that the reference, taken as a whole, fails to provide any explicit showing as to dissuade anyone having ordinary skill in the art from contemplating the apparatus recited by claim 1. However, to establish a *prima facie* case of

obviousness, there must be some suggestion or motivation to modify the reference. It is submitted that it is not a requirement to establish obviousness that a reference must explicitly dissuade against modification resulting in an invention. Therefore, it is submitted that the rejection over Youman cannot be sustained.

Youman et al. fails to teach or suggest "an alphabetical sort of the programs in response to the user selection of the program descriptive field and an entered text string" as recited by the present claim 1. The system taught in Youman always displays the programs alphabetically by title and does not teach or suggest performing an alphabetical sort of the programs based on any criteria. If a user selects a program descriptive field, the system displays a subset of the program titles, still displayed alphabetically by title, limited only by the program descriptive field selected on the previous screen. No sorting is performed, only the removal of program titles from the displayed list. This is demonstrated by the examiner's example where "Made in America" is always listed before "Magic Kid." In the solution taught by the present invention, an alphabetical sort on the program descriptive field "STAR" for example, may result in "Magic Kid" being listed before "Made in America" because the alphabetical sort is based on a criteria other than title. It is submitted that since Youman et al. does not teach or suggest this limitation, that a *prima facie* case of obviousness cannot be established and therefore the rejection over Youman et al. cannot be sustained.

The examiner proposes the combination of Youman with the database interface of Torres. It is submitted that the examiner however used improper hindsight reasoning when concluding that the present invention is obvious in light of the combination of Youman and Torres. *In Re McLaughlin*, reveals that the court defines the test for combining references as "what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art." *In re McLaughlin*, (443 F.2d 1392) It is submitted that there is no motivation in either Youman or Torres to combined the references to create a program guide user interface

to create a "control means for displaying concurrently a list of program descriptive fields and an entry for entering a text string" as recited by the currently amended claim 1. It is respectfully submitted therefore that the suggestion or motivation for the examiner's proposed combination of Youman et al. and Torres can only originate from within the applicant's disclosure.

It is submitted that Torres is non-analogous art and therefore any rejection over Youman in view of Torres cannot be sustained.

In determining whether art is analogous, two criteria have evolved:

- (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and
- (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed.Cir.1986)

MPEP §2141.01 (8th edition, rev. 2, 2004)

In the present case, Torres cannot be considered analogous art and therefore cannot be combined with Youman to form a rejection.

Torres is a computer data base system comprising a computer and software. (Fig. 1) It is submitted that "one of ordinary skill in the art," which in the present case would be a user interface designer, would not look to the computer program field to find a solution for a program guide. Even though both systems deal with finding information in databases, a guide displaying program information must be manipulated through a simple user interface where a computer interface can be as complex as required, as is evidenced by Figure 4. The system in Torres would be impossible to navigate using a standard program guide user interface, such as a remote control.

It is submitted that the art disclosed in Torres is not reasonably pertinent to the problem the present application addresses. The problem addressed by the present invention is the difficulty in locating a desirable program in a fixed guide format. (page 3, lines 11-16) The present invention provides an easy and efficient way to search for a program based on different program descriptive fields. The system in Torres is directed at a method for providing a "dynamic dialog" between a data processing machine and a user to accelerate generation of search arguments leading to the recovery of specific data from a database. (Col. 1, lines 11-18) It is submitted that the problem addressed by Torres is not reasonably pertinent to the problem addressed by the present invention and therefore rejection over the combination of Youman and Torres cannot be sustained.

For at least the foregoing reasons, claim 1 is allowable over the prior art of record. Claims 2-5 depend from claim 1, and it is submitted that they are allowable for at least the reasons that claim 1 is allowable.

CLAIM 6-11

In addition to the reasons discussed above in connection with claim 1, the invention as recited in independent claim 6 is not rendered obvious by the combination of Youman and Torres proposed by the Examiner, as the proposed combination would not result in all of the limitations of claim 6.

The invention of claim 6 is a method for processing program guide information including the steps of "performing an alphabetical sort of the program guide information based on the selected program descriptive field" and "displaying concurrently the list of program descriptive fields, an entry for entering a text string, and the alphabetically sorted program guide information."

The examiner concurs that Youman et al. does not disclose "displaying concurrently a list of program descriptive fields" and "an entry for entering a text string" as recited by the current claim 6. However, the examiner continues to assert that these features would be an obvious design choice to one skilled in the art. As with claim 1, the examiner again asserts erroneous standard that prior art reference must explicitly teach away from the claimed invention to not be considered an obvious design choice. However, to establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the reference. It is submitted that it is not a requirement to establish obviousness that a reference must explicitly dissuade against modification resulting in an invention and that the rejection over Youman cannot be sustained.

Youman et al. fails to teach or suggest "performing an alphabetical sort of the program guide information based on the selected program descriptive field" as recited by the present claim 6. As was shown above in the response to the rejection of claim 1, the system taught in Youman always displays the programs alphabetically by title and does not teach or suggest performing an alphabetical sort of the programs based on any criteria. No sorting is performed, only the removal of program titles from the displayed list. It is submitted that since Youman et al. does not teach or suggest this limitation, that a *prima facie* case of obviousness cannot be established and therefore the rejection over Youman et al. cannot be sustained.

For at least the foregoing reasons, claim 6 is allowable over the prior art of record. Claims 7-11 depend from claim 6, and it is submitted that they are allowable for at least the reasons that claim 6 is allowable.

CLAIM 12-13

In addition to the reasons discussed above in connection with claims 1 and 6, the invention as recited in independent claim 12 is not rendered obvious by the combination of

Youman and Torres proposed by the Examiner, as the proposed combination would not result in all of the limitations of claim 12.

The invention of claim 12 is an apparatus for processing program guide information comprising a control means for displaying concurrently a list of program descriptive fields and an entry for a text string. The apparatus further comprises a control means for performing an alphabetical sort of the programs based on a selected program descriptive field, modifying the channel guide in response to the user selection of the program descriptive field and locating a first program based on an entered text string.

The examiner concurs that Youman et al. does not disclose "displaying concurrently a list of program descriptive fields" and "an entry for entering a text string" as recited by the current claim 12. However, to establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify the reference. Since Youman et al does not teach or suggest "displaying concurrently a list of program descriptive fields" and "an entry for entering a text string," it is submitted that the rejection over Youman cannot be sustained.

Youman et al. fails to teach or suggest control means for performing an alphabetical sort of the programs based on a selected program descriptive field, modifying the channel guide in response to the user selection of the program descriptive field and locating a first program based on an entered text string. As was shown above in the response to the rejection of claim 1, the system taught in Youman always displays the programs alphabetically by title and does not teach or suggest performing an alphabetical sort of the programs based on any criteria. No sorting is performed, only the removal of program titles from the displayed list. It is submitted that since Youman et al. does not teach or suggest this limitation, that a *prima facie* case of obviousness cannot be established and therefore the rejection over Youman et al. cannot be sustained.

For at least the foregoing reasons, claim 12 is allowable over the prior art of record. Claim 13 is dependant from claim 12, and it is submitted that they are allowable for at least the reasons that claim 12 is allowable.

VIII CONCLUSION (not required - optional)

Neither of the cited references teaches all of the limitations of the independent claims. The cited references, either alone or in combination, do not teach the exemplary limitations of either (1) displaying concurrently a list of program descriptive fields; or (2) performing an alphabetical sort of the programs based on a selected program descriptive field and a text string. Accordingly, it is respectfully submitted that the rejection of Claims 1- 13 should be reversed.

Respectfully submitted,

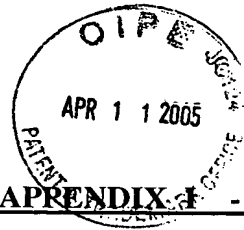
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March 31, 2005



APPENDIX 1 - APPEALED CLAIMS

1. (Previously Amended) An apparatus in which program guide information containing a respective program description for programs is processed to form a program guide, comprising:

control means for displaying concurrently a list of program descriptive fields and an entry for entering a text string;

user control means for allowing a user to select a program descriptive field from the list of program descriptive fields and to enter a text string having one or more user-selectable characters in the entry; and

the control means for performing an alphabetical sort of the programs in response to the user selection of the program descriptive field and for locating a first program with the respective program description in the selected program description field in response to the entered text string based on the entered text string.
2. (original) The apparatus of claim 1 wherein the control means further causing the alphabetically sorted programs to be displayed starting with the first program.
3. (original) The apparatus of claim 1 wherein the program descriptive field may relate to title, star, director, or context of the programs.
4. (original) The apparatus of claim 1 wherein the control means performs the alphabetical sort of the programs by first moving any sentence articles of the respective program description to the end of the respective program description.
5. (original) The apparatus of claim 1 wherein if the control means fails to locate the first program having a program description matching the entered text string, the next program on the alphabetical sorted list immediately following the position where said first program would have been located is selected instead.

6. (previously amended) A method for processing program guide information containing a respective program description for programs, comprising the steps of:
 - displaying concurrently a list of program descriptive fields and an entry for entering a text string;
 - selecting a program descriptive field from the list of program descriptive fields,
 - performing an alphabetical sort of the program guide information based on the selected program descriptive field,
 - displaying concurrently the list of program descriptive fields, the entry for entering a text string, and the alphabetically sorted program guide information;
 - entering a text string having one or more user-selectable characters in the entry; and
 - locating a first program with the respective program description in the selected program description field matching the entered text string.
7. (original) The method of claim 6 further comprises the step of displaying the alphabetical sorted list of programs starting with the first program.
8. (original) The method of claim 6 wherein the program descriptive field may relate to title, star, rating, director or content of the programs.
9. (original) The method of claim 6 wherein the performing step further comprises the step of first moving any sentence articles of the respective program description to the end of the respective program description.
10. (original) The method of claim 6, wherein if the locating step cannot locate the first program matching the entered text string, the next program on the alphabetical sorted list immediately following the position where the first program would have been located is selected instead.

11. (original) The method of claim 6, further comprising the step of if another program descriptive field is selected from the list of the program descriptive fields, performing an alphabetical sort of the programs based on the entered text string and the another selected program descriptive field.

12. (previously amended) An apparatus in which channel guide information containing a respective program description for programs is processed to form a channel guide, comprising:

control means for displaying concurrently a list of program descriptive fields and an entry for entering a text string;

user control means for allowing a user to select a program descriptive field from the list of program descriptive fields and to enter a text string having one or more user-selectable characters in the entry; and

the control means for performing an alphabetical sort of the programs based on the selected program descriptive field, modifying the channel guide based on the selected program descriptive field, and for locating a first program with the respective program description in the selected program description field matching the entered text string based on the entered text string.

13. (original) The apparatus of claim 12 wherein the controller further causing the alphabetically sorted programs to be displayed starting with the first program, concurrently, with the list of program descriptive fields.